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EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,380

Applicant(s)

MANSFIELD ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Claim 11 has been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Drawings

3. New drawings were received on Dec 23, 2003, but will not be considered until the accompanying substitute specification is entered.
4. The drawings filed July 9, 2003 are objected to as failing to comply with:

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- a. 37 CFR 1.84(h)(5) because Fig. 8 shows modified forms of construction in the same view. See fixed retainer 340 and “THREADED DESIGN”.
- b. 37 CFR 1.84(p)(4) because:
 - i. Reference numeral 27 identifies an upper end of body 26 in Fig. 2 (see also page 8, line 1) and an unidentified object or feature in Fig. 3.
 - ii. Reference numeral 31 identifies a machined area in Figs. 2 & 5 (see also page 7, line 19), an unidentified object in Fig. 1, and another unidentified object or feature in Fig. 3.
 - iii. Reference numeral 38 identifies a bearing in Figs. 1, 3 & 5 (see also page 8, line 2) and an unidentified object or feature in Fig. 4.
 - iv. Reference numeral 52 identifies a stepped surface in Fig. 4 (see also page 8, line 10) and an unidentified object or feature in Fig. 2.
 - v. In Fig. 1 reference numerals 64 & 66 are each used twice to identify two different parts.
 - vi. Reference numeral 50 identifies a port in Figs. 2, 3 & 5 and an O-ring in Fig. 4.
 - vii. In Fig. 3 reference numeral 39 appears to indicate internal threads in spanner nut/retainer 40. It does not appear to indicate external threads on body 26 as in Fig. 2 and on page 8, line 6. (Note in Fig. 2 that spanner nut 40 engages only a portion of the threads 39.)
 - viii. Reference numeral 54 identifies a port in Fig. 3, a protrusion in Fig. 4, and wall in Fig. 5.

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- ix. In Fig. 7 reference numeral 140 should be changed to 240. See page 12, line 2.
- c. 37 CFR 1.84(p)(5) because they do not include:
 - i. Reference numeral 16 mentioned in the description on page 6, line 10.
 - ii. Reference numeral 131 mentioned in the description on page 10, line 19.
 - iii. Reference numeral 257 mentioned in the description on page 11, line 19.
 - iv. Reference numeral 239 mentioned in the description on page 12, line 1.
 - v. Reference numeral 275 mentioned in the description on page 12, line 2.
 - vi. Reference numeral 260 mentioned in the description on page 12, line 3.
 - vii. Reference numeral 341 mentioned in the description on page 12, line 18.
 - viii. Reference numeral 396 mentioned in the description on page 12, line 20.
 - ix. Reference numeral 330 mentioned in the description on page 12, line 21.
- d. 37 CFR 1.84(p)(5) because they include the following reference numerals which are not mentioned in the description:
 - i. Fig. 1: 21, 22, 38
 - ii. Fig. 2: 99
 - iii. Fig. 2A: 108
 - iv. Fig. 3: 38A
 - v. Fig. 6: 158

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5. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The substitute specification filed Dec 19, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because the statement as to lack of new matter under 37 CFR 1.125(b) is missing.

7. The originally filed specification is objected to because:

a. The application mentioned on page 1 should be identified by its patent number.

b. On page 6, line 12 reference numeral 17 is used to identify a clutch assembly but on page 7, line 8 it used to identify an upper gearset.

c. On page 6, line 15 reference numeral 60 is used to identify a spanner but on page 8, line 13 it used to identify an O-ring seal.

d. Page 8, line 13 includes the sentence "The lower end of the shaft 19 is connected to the lower pinion gear 68 and the shim 65, lower bearing 64, preload shim 61 installed." The meaning of the sentence is not clear. Fig. 5 shows lower shim 65 at the top end, not the lower end, of shaft 19.

e. On page 8, lines 17 & 19 reference numeral 47 is used to identify a surface but in line 19 it used also to identify a flange.

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- f. On page 8, line 19, the bore 48 is described as being "in the flange 47" but Fig. 2A shows the bore 48 in the flange 42.
 - g. On page 12, line 7 the reference numeral 236 should be changed to 326.
 - h. On page 12, lines 19 & 22 the reference numeral 356 should be changed to 350. See Fig. 8.
 - i. On page 12, line 20 "4" should be changed to "four".
8. The listing of references in the specification as on page 1 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the reference has been cited by the examiner on form PTO-892, it has not been considered.
9. The specification is objected to as failing to comply with 37 CFR 1.71 and 1.75(d)(1) because the detailed description fails to provide proper antecedent basis for limitation "said body is fabricated from . . . stainless steel" in claim 5.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 not previously cited that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1-3, 6-8 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Mixer, US 301,512. Fig. 2 shows an upper gearset support comprising: a generally axially body (the right element B) dimensioned to extend substantially the length of an upper case body defining an internal bore to receive a drive shaft and/or a bearing, the body having an upper end (left end) and a lower end (right end). The upper end of the body B is configured to receive an upper gearset and clutch assembly. Fig. 2 shows the upper gearset support further comprising a first retainer (the element A on the left end of the right element B) and a second retainer (the element A on the right end of the right element B) on the body. Fig. 2 shows both retainers A are threaded on the body B and so therefore both retainers are adjustable relative to the body to secure the support in engagement with a housing. Each retainer A includes at least one bore. The surface of each retainer A is configured to conform to the peripheral surface area of an upper case.

12. Claims 1-3, 6-8 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark, US 924,039. See in Fig. 2 the support comprising body 13 having two threaded ends with two retainers adjustable thereon.

13. Claims 1-3, 8 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Travis, US 5,813,706. Fig. 4 shows an upper gearset support comprising: a generally axially body 30 dimensioned to extend substantially the length of an upper case body defining an internal bore to

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receive a drive shaft and/or a bearing, the body having an upper end 34 and a lower end 36. The upper end of the body is configured to receive an upper gearset and clutch assembly. Fig. 4 shows the upper gearset support further comprising a first adjustable retainer 40 and a second retainer 38. Fig. 2 shows the first retainer 40 includes at least one threaded bore 50.

14. Claim 9/1 is rejected under 35 U.S.C. 102(a) as being anticipated by Payne, US 6,254,443. Figs. 2 & 3 show an upper gearset support comprising: a generally axially body 10 dimensioned to extend substantially the length of an upper case body defining an internal bore to receive a drive shaft and/or a bearing, the body having an upper end and a lower end. The upper end of the body is configured to receive an upper gearset and clutch assembly. Fig. 3 shows the upper gearset support further comprising a first retainer/flange 13 and a second retainer 23 on the body. Fig. 3 shows the second retainers 23 is adjustable relative to the body to secure the support in engagement with a housing. The surface of the second retainer 23 is configured to conform to the peripheral surface area of an upper case. In col. 3, line 3 the support is disclosed as being made from 4130 machine steel. Fig. 3 shows the upper end of the body carries a bearing cup 19b.

Claim Rejections - 35 USC § 103

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mixer in view of Metzger, US 1,186,325. In Figs. 1 & 2 Mixer shows retainer A with a plain bore for receiving a fastener D but does not show the bore as threaded. In Figs. 4 & 5 Metzger shows that a retainer F2 with a threaded bore (for receiving a fastener G) is an art recognized equivalent of a retainer I

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with a plain bore (for receiving a fastener J). Therefore it would have been obvious to one of ordinary skill in the art to modify the support of Mixer by providing the retainer with a threaded bore instead of a plain bore because plain and threaded bores are art recognized equivalent fastener receiving bores as shown in Metzger.

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Mixer, Clark and Travis. Each reference shows every limitation of the claim but none shows or suggests making the body from chrome moly or stainless steel. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the body of any one of the supports in the prior art from chrome moly or stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

17. Applicant's arguments filed Dec 23, 2003 have been fully considered but they are not persuasive.

a. In response to applicant's argument that the 102b prior art references fail to disclose use within a gear and clutch assembly of a marine stern drive unit, a recitation of the intended use of the claimed invention must result in a **structural** difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

b. Applicant argues that none of the references is directed to the problem solved by the instant invention. However, the instant invention is not a method of solving a particular problem. Rather the instant invention is an apparatus comprising a set of structural limitations which is capable of performing a set of functional limitations. Therefore a reference need only show or suggest an apparatus comprising those limitations in order to anticipate the claim. There is no requirement that the prior art show or suggest a method of solving a particular problem unless the instant invention is such a method.

c. Applicant argues that the prior art fails to show the upper end of a support that is configured to receive an upper gearset and clutch assembly. However, Mixer clearly shows both ends of support body B configured with a bore that could receive an upper gearset and clutch assembly.

d. Applicant argues that, in view of the declaration filed Dec 23, 2003, the prior art to Payne cannot be used to reject applicant's claims. However, the limitations of claim 9 were not disclosed in applicant's parent application and therefore that claim does not enjoy the benefit of the earlier filing date of the parent application. As such Payne is available under 102a for a rejection of claim 9.

e. Applicant argues that Payne fails to show or suggest the claimed invention because the support 10 is not shown as extending the entire length of the upper housing 11 shown in Fig. 1 of Payne. However, the instant claims require only that the body of

the claimed invention (i.e. a support) be **dimensioned** to extend the length of an upper case housing. The claims do NOT recite the claimed invention as a housing in combination with a support having a particular body length. As such it does not matter that Payne fails to show the support 10 extending the length of housing 11, it only matters that Payne shows a support 10 that is dimensioned to extend the length of a housing, any housing, including a housing having a length equal to, or less than the length of the support 10.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakese et al discloses in col. 1, lines 26 & 50 and col. 4, line 43 that stainless steel is a suitable material for the body of an upper gear set support.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. This application contains claim 11 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (703) 308-1159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
Art Unit 3679